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REMARKS

The Examiner is thanked for the thoroughness of the Office Action. The claims have been carefully reviewed in light of the rejections contained therein. Reconsideration of the application in view of the foregoing amendments and the following remarks is respectfully requested.

In amended Figure 5, the previously mislabeled line C-C' has been corrected to B-B' and previously mislabeled Figure 5C properly relabeled as 5B. Figure 5 was previously thus amended in a Preliminary Amendment submitted on 5 September 2002. Although Applicant believes the amendments made therein to have been in proper format for entry under the rules then in force for making amendments to the drawings, in an abundance of caution Applicant resubmits in Appendix A hereto amendments to Figure 5 consistent with, and in the format required by, the amended rules currently in force.

Claims 1-22 remain in this application. Claims 1, 11, 13, 15, 20-21, and 23 have been amended. Claims 24-29 have been added.

Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "selected from a plurality..." has been deemed to be vague and indefinite because it is not clear if applicant is positively reciting and claiming a single forefoot piece or a plurality of forefoot pieces. Claim 1 has been amended and claim 24 added to more positively recite and claim this aspect of the present invention. Applicant respectfully submits that the amendment overcomes the rejection and respectfully requests reconsideration and withdrawal thereof.

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In claim 11, the phrase "capable of initiating..." is deemed to be functional, indefinite, and incomplete because it contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence of such language. The Office Action stated that it is not clear what structural limitations applicant intends to encompass with such language. Claim 11 has been amended to more positively recite and claim the invention. Applicant respectfully submits that the amendment overcomes the rejection and respectfully requests reconsideration and withdrawal thereof.

In claim 13, the phrase "torsional geometry" has been deemed to be confusing, vague, and indefinite. Claim 13b has been amended to more positively recite and claim the invention. Applicant respectfully submits that the amendment overcomes the rejection and respectfully requests reconsideration and withdrawal thereof.

Claims 1, 2, 4-6, 8-10, 12, 13, and 15 are rejected under 35 U.S.C. § 102(e), as being clearly anticipated by *Erickson* (U.S. Pat. No. 6,408,543). The Office Action states that *Erickson* shows an insole comprising a heel piece (24), a forefoot piece (22), interlocking and retaining means (26, 42, 58, 25b, and 59), and a forefoot cushioning means (27), as claimed.

Applicant respectfully submits that *Erickson* requires that the solepad include a cushioning structural element, such as a filled bladder, in the region underlying the ball of the foot. The device of the present invention contains no such limitation. Claim 1 has been amended to clarify that no such cushioning function is necessary for the forefoot piece of the present invention. Rather, the present invention permits use of a forefoot piece having no, or negligible, cushioning effect.

Applicant respectfully submits that the point of invention of the present invention resides in the capability of the assembled device to support the foot in a neutral orientation. Significant wear and tear of both shoes and anatomy result from "fallen arches," more properly known as

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pronation of the foot, and also of its opposite: supination. Furthermore, different leg lengths and foot widths are more common than not.

Because most individuals have one foot that is up to a half size wider than the other, only one foot may properly be accommodated by most footwear. Thus, either the wider foot is squeezed into a narrower shoe, or a narrower foot must slide around in a wider shoe. The present invention enables a user to use a standard forefoot piece for use with the wider foot and a thicker forefoot piece that occupies more volume in the footwear for the narrower foot. Thus, both feet are properly accommodated within footwear having a width comfortable for the wider foot. By selecting the correct combination of forefoot and heel pieces, a user of the device of the present invention may correct all of these conditions.

Likewise, most individuals have one leg that is slightly shorter than the other. This may result in significant back problems, as the pelvis must rotate to functionally equilibrate leg length while standing, walking, or running. However, this situation may be corrected in a device of the present invention by the user selecting for the shorter leg a heel piece that is slightly thicker in the region underlying the heel.

In addition to the above distinctions, the solepad of *Erickson* extends substantially the length of the human foot (see col. 1, lines 24-26) and also substantially the full width of the foot throughout its length. In sharp contradistinction, the device of the present invention may comprise a forefoot piece and a heel piece that extend the full length and width of the human foot only when joined together. Claim 29 has been added to make clear the distinction that the forefoot piece of the present invention is not required to extend the full length of the foot and the full width of the foot throughout the length of the forefoot piece.

Claims 1, 2, 5, 6, 8, and 16-18 are rejected under 35 U.S.C. § 102(b), as being anticipated by *Torchia* (U.S. Pat. No. 1,733,678). The Office Action states that *Torchia* shows an insole

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comprising a heel piece (1 and 2) with a first interlocking means (6), a forefoot piece (11) with a second interlocking means (12), means for retaining the pieces together (frictional engagement), and a heel cup (formed by element 15 and 14), as claimed.

Applicant respectfully submits that *Torchia* relates to an adjustable orthotic device that is contemplated to "extend from the heel to a point just in rear of the ball of the foot...." (see col. 1, lines 7-10.) The device of *Torchia* comprises a supporter having a plurality of laterally disposed pockets into which various structural support elements may be partially inserted. In contrast, the present device extends throughout the length of the foot and is intended to optimize the fit of the shoe, in addition to optionally providing cushioning and support. The device of the present invention does not comprise laterally disposed pockets, nor may any of the elements of the present invention be partially inserted into the periphery of any other element(s). For these reasons, and in light to the amendments to the claims, Applicant respectfully requests reconsideration and withdrawal of the rejection based on *Torchia*.

Claims 1, 2, 4-6, 8-10, and 19-22 are rejected under 35 U.S.C. § 102(b), as being anticipated by *MacNamara* (U.S. Pat. No. 6,092,311). The Office Action states that *MacNamara* shows an insole comprising a heel piece (20) with first interlocking means (64, see column 4, lines 20-25), forefoot pieces (30, 40, and 50) some with a forefoot centering periphery (shown in figures 1A and 1B), and second interlocking means (62), as claimed.

Applicant respectfully submits that *MacNamara* relates to a series of progressively sized unitary insoles that may be attached to the interior surface of the shoe outsole. These insoles are intended to enable parents to buy a larger size shoe for their child, yet optimize the fit of the shoe as the child grows. These insoles may be provided with interlocking means that mateably engage corresponding means provided along the interior surface of the shoe outsole. In contrast, the present device comprises a forefoot piece and a heel piece and the interlocking means is designed

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such that each of these pieces may engage each other, not the outsole of the shoe. For these reasons, and in light to the amendments to the claims, Applicant respectfully requests reconsideration and withdrawal of the rejection based on *MacNamara*.

Claims 3, 7, 14, and 23 are rejected under 35 U.S.C. § 103(a), as being unpatentable over *Erickson or Torchia*. The Office Action states that, "*Erickson* shows an insole substantially as claimed except for the exact means for retaining the interlocking means together and the exact material hardnesses. The use of adhesive to retain elements together is well known and conventional and also low tack adhesives are a well known alternative to hook and loop fasteners. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416." The Office Action further states that, "it would have been obvious to provide adhesive and to use materials with hardnesses as claimed in the insole of either *Erickson or Torchia* to prevent the elements from sliding apart and to provide appropriate support and durability materials."

Applicant respectfully re-emphasizes that the patentability of the presently claimed invention does not reside in the exact means for retaining the interlocking means together or to the exact material hardnesses, but, rather, by the unexpected performance characteristics attained at reasonable cost by the device claimed. There is no suggestion in any pertinent reference, either alone or in combination with another, that the unexpected performance levels and ancillary benefits achieved by the presently claimed invention are possible in a commercially viable sockliner. For these reasons, and the points presented above with reference to the rejections made under 35 U.S.C. § 102, Applicant believes his invention as claimed to be in condition for allowance and respectfully requests such action.

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Claim 11 is rejected under 35 U.S.C. § 103(a), as being unpatentable over either *Erickson* or *Torchia* in view of *Dahle* (U.S. Pat. No. 5,230,170). The Office Action states that, "*Erickson* or *Torchia* shows an insole substantially as claimed except for a chemically reactive forefoot pad. *Dahle* teaches providing a chemically reactive forefoot pad (42) in an insole. It would have been obvious to provide a chemically reactive forefoot pad as taught by *Dahle* in the insole of either *Erickson* or *Torchia* to provide warmth to the foot in cold weather."

The rejection of claim 11 under 35 U.S.C. § 103 is based on the combination of the references cited above. Applicant maintains that such a combination would not be obvious to one of ordinary skill in the art. Indeed, even if the references are combined, the claimed invention is not achieved. Applicant respectfully submits that, for the reasons stated above, the presently claimed apparatus is patentable over both *Erickson* and *Torchia*, and, for these reasons, claim 11 is likewise patentable.

Accordingly, Applicant believes his invention as claimed to be in condition for allowance and respectfully requests reconsideration and withdrawal of the outstanding rejections and that a timely Notice of Allowance be issued in this case. If any questions remain, please contact Applicant's attorney, Timothy J. Shea II, collect at the number given below.]

Respectfully submitted,

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